

M72-135694M/SW
Amendment dated 11/25/2005

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Reply to office action mailed 09/01/2005

REMARKS

Claims 2-18 are currently pending in the application. By this amendment, claims 2, 3 and 18 are amended for the Examiner's consideration. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each.

The Examiner's indication that claims 3-6 contain allowable subject matter is acknowledged with appreciation. Claim 3 has been amended to independent form, and therefore claims 3-6 are believed to be allowable as amended, and allowance is respectfully requested.

The Examiner has rejected claims 2, 7, and 14 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,055,592 to Smith in view U.S. Patent No. 6,417,911 to Kniazzeh et al. ("Kniazzeh"). The Examiner's comments in support of this rejection are the same as in the prior office action, except for additional citation to Smith in response to the "bidirectional" limitation added in the RCE. Consequently, in order to advance the prosecution, the prior remarks entered by the RCE are incorporated by reference so that these remarks may focus on the new material and argument provided by the Examiner.

In summary, the applicant contends that unobtrusive inclusion within a mouse casing of a removable data storage medium, using the mouse interface so that the removable data storage medium is directly accessible as auxiliary data storage by the computer, is novel and non-obvious in view of the prior art. The purpose of the "bidirectional" limitation added in the RCE was to make clear that the data stored on the removable data storage device was indeed accessible as auxiliary storage (i.e. both read and write) by the personal computer.

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As the Examiner points out, the “bidirectional” limitation reads on the communication path described in Smith, which handles pointing device position data both a) as requested by the computer (col. 3, lines 31-41) and b) as provided to the computer by the mouse system (col. 3, lines 12-17). However, pointing device position data – and requests for such data from the computer – are a conventional part of the operation of pointing devices and this kind of data has nothing to do with the data stored on the removable device directly accessible as an auxiliary storage device by the personal computer. The Examiner’s recognition of this imprecision in the claimed subject matter is acknowledged with appreciation.

It should be noted that the use of “pointing device codes” to represent “card codes” (col. 3, line 34) appears to be unidirectional, that is, the “card code” data is transmitted to the computer (after conversion into “pointing device codes” using an access technique “determined by a software program running in computer 212”, col. 4, lines 1-17) but there is no indication that the computer writes data back to the card. Consequently, for clarity, the language of claim 2 has been amended to specify that the “data” which is communicated “bidirectionally” refers to data stored in the removable data storage medium.

In order to further clarify what the applicant believes is novel and nonobvious, note is taken of the Examiner’s remarks that prior argument was not persuasive because the claims did not recite “an auxiliary storage medium” but only “removable data storage medium.” It is clear that the inventors contemplated a storage medium directly accessible as auxiliary data storage by the personal computer using the existing interface provided by the mouse (page 3, lines 6-9; compare prior art requirements of an additional interface device, as described at page 2, lines 5-13). Consequently, the language of claim 2 has been amended further to provide that the

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“removable data storage medium” is “directly accessible as an auxiliary storage device by the personal computer via the mouse interface.”

It is therefore believed that claim 2 is now in allowable form.

In response to the Examiner’s argument regarding the door disclosed in the Kniazzeh reference, please note that the door 624 shown in Fig. 6 is anything but unobtrusive. The door 624 clearly protrudes from the surface of the device 610. In contrast, the language of claim 2 describing the “door member” implements the objective of the invention described at page 2, lines 14-18, and page 3, lines 18-20. The “operability of the mouse” would be “deteriorated” if the door member protruded from the surface of the mouse casing in the manner shown by Kniazzeh. Thus the two part claim language (first: the door member covers the opening; second, when closed, the door member “constitutes a part of an outer face of the casing body”) defines a door which unobtrusively covers the opening. While the claim language does not use the word “unobtrusive” the functionality of the claimed limitations is equivalent.

The Examiner has rejected claims 8-11 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,055,592 to Smith in view U.S. Patent No. 6,417,911 to Kniazzeh et al. (“Kniazzeh”), and further in view of U.S. Patent No. 5,559,672 to Buras, Jr. et al. (“Buras”). Since these claims depend from claims now believed to be in allowable form, it follows that claims 8-11 and 13 are in allowable form as well, and this ground of rejection is overcome.

The Examiner has rejected claims 15-17 under 35 U.S.C. §103(a) as being unpatentable over Smith in view of Kniazzeh and further in view of U.S. Patent No. 6,198,473 to Armstrong. Armstrong discloses the use of wireless, USB and PS/2 connections between the mouse and the computer. These varieties of connectivity are

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well known in the art. However, claims 15-17 depend from claim 2, which is believed to be in allowable form and therefore claims 15-17 are also allowable.

The Examiner has rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Smith in view of Kniazzeh and Buras and further in view of U.S. Patent No. 4,807,749 to Ackeret. Ackeret discloses a moveable slider member for temporary storage of recording media. There is no suggestion in Ackeret that the recording media is to be used for either reading or writing data while inserted in the storage compartment. However, in any event, claim 12 is ultimately dependent upon claim 2, which is believed to be in allowable form, and therefore claim 12 is also allowable.

The Examiner has rejected new claim 18 under 35 U.S.C. §103(a) as being unpatentable over Smith in view of Kniazzeh as applied to claim 2, and further in view of U.S. Patent No. 5,794,553 to Futamura. It is not disputed that auxiliary storage devices for reading and writing are old in the art. Futamura uses such a device in an embroidery data processing apparatus. However, this is not relevant to the issue in the case. The present invention provides an auxiliary read/write storage device conveniently and unobtrusively in a mouse casing and through an existing mouse interface. This combination is not suggested by the well known existence of auxiliary storage devices. Nor is it suggested by Smith, which provides only a mechanism for reading authentication data from a smart card. Smith does not suggest bidirectionality with respect to data stored on the smart card, nor do the well known auxiliary storage devices suggest connecting such devices through a mouse housing and controller. Further, since Smith's smart card does not suggest bidirectionality with respect to data stored on the smart card there is no motivation to add to Smith the functionality of a data storage device directly accessible for both read and write operations. The claim has been amended to fully claim the subject matter described

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by the invention, which covers other devices to which the mouse and its removable storage may be connected (page 3, lines 6-9). Thus it is submitted that the Examiner's rejection of claim 18 is overcome.

In view of the foregoing, it is requested that the application be reconsidered, that claims 2-18 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,



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